

REMARKS

Claims 10-28 stand rejected under 35 U.S.C. § 101 as being directed toward non-statutory subject matter. Claims 1-28 stand rejected for obviousness under 35 U.S.C. § 103(a) as being unpatentable over Dunn et al., (U.S. Patent No. 7,428,750) (hereafter "Dunn") in view of Bussler et al., (U.S. Pat. No. 7,072,898) (hereafter "Bussler"). Applicants presently amend the claims and the specification to cure the rejections under 35 U.S.C. § 101. As will be shown below, moreover, neither Dunn nor Bussler, either alone or in combination, teaches or suggests a method, system, or computer program product for cross domain security information conversion as claimed in the present application. Claims 1-28 are therefore patentable and should be allowed. Applicants respectfully request reconsideration of claims 1-28.

Claim Amendments

Applicants presently amend claim 1 of the present application to include "wherein the canonical format is a data format for security information that is standardized for use in data transformations of security information", as supported in the Specification, for example, at page 7, line 4-10. Applicants presently amend claims 19-25, and 27-28 of the present application to recite a recordable computer-readable medium. Applicants submit that these amendments do not introduce new subject matter into the present application.

Claim Rejections – 35 U.S.C. § 101

Claims 10-28 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. The Office Action at page 5, states:

Claims 10-28 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. These claims do not restrict the claimed invention to statutory classes of invention. Rather, the specification defines computer program products embodied on a recording medium to encompass transmission media. (See Specification, pg. 6, line 22) Hence, these claims are limited to statutory subject matter.

That is, the Office Action takes the position that Applicants' usage of the term 'recording medium' in claims 19-28 renders Applicants' claims outside realm of statutory subject matter because 'recording medium' encompasses 'transmission medium.' In response, Applicants have amended the Specification remove the reference to 'transmission medium'. The relevant portion of the Specification, as amended, reads as follows:

The invention also may be embodied in a computer program product, such as a diskette or other recording medium, for use with any suitable data processing system. Embodiments of a computer program product may be implemented by use of any recording medium for machine-readable information, including magnetic media, optical media, ~~transmission media,~~ or other suitable media.

That is, the Specification as presently amended no longer defines a recording medium to encompass a transmission medium.

Applicants also amend Claim 19 in this Response to add to claim 19 the limitation that the the computer program product is embodied on a recordable computer-readable medium, thereby further clarifying that the claims in this case can no longer be read to include a transmission medium. Claim 19, and claims 20-28 which depend from claim 19, are therefore statutory.

In paragraph 7 of the Office Action, the examiner recites a rejection of claims 10-29 under 35 U.S.C. § 101, apparently including claims 10-18 in the § 101 along with claims 19-28. Applicants have cured the rejections of claims 19-28 by amendment as noted above. Regarding the apparent rejection of claims 10-18, Applicants respectfully submit that the rejection appears to have been a clerical error in which the examiner actually intended to refer only to claims 19-28 and typed 10-28 by mistake. Applicants further note that in fact claims 10-18 are directed to apparatus, that is, to a system for cross domain security information conversion, not a computer program product, and are therefore entirely statutory. Applications respectfully request that the rejection of claims 10-28 under 35 U.S.C. § 101 be withdrawn.

Claim Rejections – 35 U.S.C. § 103

Claims 1-28 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Dunn in view of Bussler. The question whether Applicants' claims are obvious is examined in light of: (1) the scope and content of the prior art; (2) the differences between the claimed invention and the prior art; (3) the level of ordinary skill in the art; and (4) any relevant secondary considerations, including commercial success, long felt but unsolved needs, and failure of others. *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1729-1730, 82 USPQ 1385 (2007). Although Applicants recognize that such an inquiry is an expansive and flexible one, the Office Action must nevertheless demonstrate a prima facie case of obviousness to reject Applicants' claims for obviousness under 35 U.S.C. § 103(a). *In re Khan*, 441 F.3d 977, 985-86 (Fed. Cir. 2006). To establish a prima facie case of obviousness, the proposed combination of Dunn and Bussler must teach or suggest all of Applicants' claim limitations. MPEP 2142 (citing *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974)). As shown below in more detail, the proposed combination of Dunn and Bussler cannot establish a prima facie case of obviousness because the proposed combination does not teach or suggest each and every element of the claims of the present application. As such, Applicants respectfully traverse each rejection individually.

**The Combination of Dunn And Bussler Neither Teaches Nor Suggests
Returning To The System Entity The Security Information
In The Native Format Of The Second Security Domain**

The Office Action takes the position that Dunn at column 19, lines 32-35, and at FIG. 4, reference number 416, discloses the following element of claim 1: returning to the system entity the security information in the native format of the second security domain. Applicants respectfully note in response, however, that what Dunn in fact discloses at column 19, lines 32-35, is:

7. The identity broker 206 finds that userA@pageB.net is linked to userA@pageA.net and is associated with the financial web site.

8. The identity broker 206 sends a request to the authentication system to validate userA@pageB.net and receives an authentication ticket from the authentication system.

And regarding FIG. 4, reference number 416, here is how Dunn, in the Dunn reference itself at column 11, lines 3-28, describes what is found at FIG. 4, reference number 416:

Referring next to FIG. 4, an exemplary flow chart illustrates identity brokering after the user has registered at least two identities with the identity broker 206. The user navigates to the target service 204 from a previous site at 402 and is authenticated at 404, 406 if necessary. In a simple case, if the user identity presented to the target service 204 is recognized by the target service 204 at 408 and an authenticated identity is not required when returning to the previous site at 410, the identity broker 206 is not invoked and the user task is completed at 412. However, if an authenticated identity is required when returning to the previous site and the identity broker 206 was used at 414, the identity broker 206 repackages the user identity to include credential information at 416 and the user task is completed at 412. If the user identity presented to the target service 204 is not recognized by the target service 204, the identity broker 206 operates to deliver an appropriate identity to the target service 204 at 420 in response to a request from the target service 204 at 418. If no appropriate identity exists in the user identity database 216, the identity broker 206 interacts with the target service 204 to register a new user identity for the user at 422. Registering a new user identity may include adding a new credential. After registering new user identity information, operation continues by determining if an authenticated identity is required when returning to the previous site at 410.

That is, Dunn at these reference points teaches an identity broker that authenticates a second identity registered by a user with the identity broker if a target service requires the second identity but the user is logged in with a first identity registered with the identity broker. Dunn teaches that if the user does not have the second identity registered with the identity broker, requesting the user to complete a registration for the second identity.

The independent claims of the present application, however, recite not one word regarding authentication of a second identity or registration of a second identity. The

independent claims, claims 1, 10, and 19, of the present application recite translation of security information to a native format of a second security domain *with no concern whatsoever regarding whether that information is then useful for authentication in a second domain or whether that security information even exists in the second domain. Whether the system entity of the present claims uses the transformed security information for authentication in the second domain or whether the system entity is eventually required by the second domain to effect some additional registration is of no concern whatsoever to the invention recited in the independent claims of the present case.*

Dunn's identity broker does not teach or suggest returning to the system entity the security information in the native format of the second security domain as claimed in the present application, that is, returning the same security information transformed into a format required by the second domain. Turning to Bussler, even if Bussler taught something about security, which it does not, nevertheless, there is nothing in Bussler that when combined with Dunn would teach or suggest returning to the system entity the security information in the native format of the second security domain. Note in particular that there is no returning function in Bussler in any way similar to or suggestive of returning to the system entity the security information in the native format of the second security domain as claimed here. On the contrary, the processing disclosed in Bussler takes the transformed data in one direction only, from source-side native phase to source-side application phase, from source-side application phase to common view phase, from common view phase to target-side application phase, and so on. But there is no teaching or suggestion in Bussler of any return from the target side to the source side. The proposed combination of Dunn and Bussler, not teaching or suggesting the returning of security information in native format of a second security domain as claimed here, cannot be said to teach or suggest all the elements and limitations of the claims of the present application. The Office Action therefore cannot establish a prima facie case of obviousness by use of the proposed combination of Dunn and Bussler. The rejections of claims 1-28 should be withdrawn, and the claims should be allowed.

**Bussler Teaches Away From Cross Domain Security Information
Conversion As Claimed In The Present Application**

Bussler actually teaches away from cross domain security information conversion, as claimed in the present application. Teaching away from the claims is a *per se* demonstration of lack of prima facie obviousness. *In re Dow Chemical Co.*, 837 F.2d 469, 5 U.S.P.Q.2d 1529 (Fed. Cir. 1988); *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); *In re Neilson*, 816 F.2d 1567, 2 U.S.P.Q.2d 1525 (Fed. Cir. 1987). The present application claims returning to the system entity the security information in the native format of the second security domain. The whole point of the claims of the present application is that the invention as claimed solves the problem that a data processing entity needs security information formatted in *both* the native formats of two security domains, that is, two different data formats needed by the same data processing entity. There is no parallel between Bussler's processing phases and the native formats of two different security domains as claimed in the present invention. The fact that Bussler discloses processing phases for data format conversion does not teach or suggest transforming formats and then returning the second format to the same entity for use in the second domain as claimed here. In fact, it is clear that once transformed for use in the target-side native phase, Bussler's only teaching is that the transformed data is used by the target application *alone*, never returned in any way for any use whatsoever by the source application, *thereby teaching directly away from such a return as claimed here*. Because Bussler teaches away from the claimed returning step in the present application, the proposed combination of Dunn and Bussler cannot support a prima facie case of obviousness.

**There Is No Rational Underpinning For The
Combination Of Dunn With Bussler
As Proposed In The Office Action**

The Office Action takes the position at page 6, paragraph 12, that the motivation to combine Dunn with Bussler is to disburse the integration of the several participants of the communication, thereby reducing the complexity of the conversion, as found in Bussler at column 2, lines 30-36. Applicants respectfully note in response, however, that the

cited teaching in Bussler provides no motivation to combine the method for exchanging communications between heterogeneous applications taught in Bussler with the method for managing multiple identities taught in Dunn to achieve the claimed invention. Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *In re Kahn*, 441 F. 3d 977, 998 (Fed. Cir. 2006), cited with approval in *KSR v. Teleflex*, 550 U.S. 398 (2007).

In the present case, no rational underpinning for the combination of Dunn with Bussler can possibly exist because the references disclose nothing that can rationally be combined. There is nothing in the references which when combined will result in security data processing as claimed here with one entity utilizing security data in native formats of two different domains. Dunn seems to have something to do with security but teaches nothing about data conversion. Bussler seems to have something to do with data conversion but teaches nothing about security. And neither reference, separately or in combination, teaches or suggests the return of a second native format to a processing entity putting two different native formats in possession of that entity. On the contrary, because Bussler teaches away from such joint use of two native formats and Dunn teaches nothing on the subject whatsoever, the combination of the two references simply would never result in the joint processing as claimed here. And with no overlap at all in the subject matter of the two references, no data conversion in Dunn, no security processing in Bussler, no rational inventor would ever be expected to turn to these two references in combination to find the joint security-related processing of two different native formats as claimed here.

Applicants further submit that the failure in this Office Action to set forth a rational underpinning for the combination of references or any motivation to combine the references is strong evidence of the use of hindsight in obviousness analysis. The Court of Appeals for the Federal Circuit recently affirmed the usefulness of the TSM test in obvious analysis, that is, teaching, suggestion, motivation. *Ortho-McNeil v. Mylan*, Slip Opinion, Case No. 1223 (Fed. Cir. 2007). Applicants respectfully submit that KSR's

injunction to examiners to expressly set forth a rational underpinning to propose a combination of references is legal reasoning parallel to the motivation element of the TSM test. “As this court has explained, however, a flexible TSM test remains the primary guarantor against a non-statutory hindsight analysis ...” *Ortho-McNeil v. Mylan, Id*, citing with approval *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). In this case, hindsight analysis is composed of the taking of two unrelated references that no inventor would ever combine and labeling an invention obvious merely because claim elements can be found by arbitrarily picking and choosing among the references with no real reason to do so. In fairness to the examiner in this case, Applicants note that it is literally impossible to express any rational underpinning or motivation for the combination – the references are just too different. So Applicants are forced, with all due respect, to the conclusion of hindsight, because, given the relationship between the claims and the cited references, hindsight is the only possible way the examiner could have made the combination. There is just no basis other than hindsight for the combination in this case.

Relations Among Claims

Independent claims 10 and 19 recite respectively system and computer program product aspects of the method of claim 1. As explained above in detail, the combination of Dunn and Bussler does not render claim 1 obvious. For the same reasons that the combination of Dunn and Bussler does not render obvious claim 1, the combination of Dunn and Bussler also does not render obvious a system or a computer program product for cross domain security information conversion corresponding to independent claims 10 and 19. Independent claims 10 and 19 are therefore patentable and should be allowed.

Dependent Claims 2-9, 11-18, and 20-28 depend from independent claims 1, 10, and 19. Each dependent claim includes all of the limitations of the independent claim from which it depends. Because the combination of Dunn and Bussler does not render obvious the independent claims, the combination of Dunn and Bussler also does not render obvious the dependent claims of the present application, which are further limitations of the

independent claims. As such, claims 2-9, 11-18, and 20-28 are also patentable and should be allowed.

Conclusion

The Office Action rejects claims 10-28 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. As explained above, Applicants' claims 10-28 as presently amended are directed toward statutory subject matter entitled to patent protection under 35 U.S.C. § 101. Applicants therefore respectfully request reconsideration of claims 10-28.


Claims 1-28 stand rejected under 35 U.S.C. § 103 as being unpatentable over Dunn in view of Bussler. As explained above, the combination of Dunn and Bussler does not render obvious Applicants' claims. Claims 1-28 are therefore patentable and should be allowed. Applicants respectfully request reconsideration of claims 1-28.

The Commissioner is hereby authorized to charge or credit Deposit Account No. 09-0447 for any fees required or overpaid.

Respectfully submitted,

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By: _____


Brandon C. Kennedy
Reg. No. 61,471
Biggers & Ohanian, LLP
P.O. Box 1469
Austin, Texas 78767-1469
Tel. (512) 472-9881
Fax (512) 472-9887
ATTORNEY FOR APPLICANTS